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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/726,589 Confirmation No. : 1848
First Named Inventor : Erik KRIMM
Filed : December 1, 2000
TC/A.U. : 3679
Examiner : Ernesto Garcia

Docket No. : 038738.49427US
Customer No. : 23911

Title : Gear Shift Mechanism Gate Plate Assembly and Method for
Producing Same

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO SECOND NOTIFICATION
OF NON-COMPLIANT APPEAL BRIEF**

Sir:

This is in response to the Second Notification of Non-Compliant Appeal Brief mailed February 15, 2006.

On February 3, 2005, Appellants appealed to the Board of Patent Appeals from the final rejection of Claims 1, 4, 8, 20, 24, and 25. The following is Appellants' Appeal Brief submitted pursuant to 37 C.F.R. §41.37.

Real Party in Interest

This application is assigned to DaimlerChrysler AG of Stuttgart, Germany, which is the real party in interest in this appeal.

Related Appeals and Interferences

Applicants, Applicants' legal representative and the assignee are not aware of any prior and pending appeals, judicial proceedings or interferences,

which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 5-7 are allowed. Claims 1, 4, 8, 20, 24, and 25 are finally rejected and form the subject of this appeal. Claims 2, 3, 9-19, 21-23, and 26-32 are cancelled.

Status of Amendments

Applicants filed an Amendment on August 9, 2005 to place Claims 5-7 in allowable form. The Amendment has been entered.

Summary of Claimed Subject Matter

Independent claim 1 is directed to a functional component as a gate plate of an automatic gear shift mechanism with a locking gate (see the specification at page 1, lines 5-10; and Figures 1-5). The functional component includes at least three stamped parts (1, 18, 19), which lie flat sandwiched against one another (see the specification at lines 6-20 of page 8, and lines 16-19 of page 9; and Figs. 4 and 5). The at least three stamped parts (1, 18, 19) are unreleasably connected to one another (see the specification from line 22 of page 10 to line 13 of page 11; and Figs. 4 and 5). Each stamped part has at least two engagement holes (4, 5) for engagement elements, and the engagement holes (4, 5) of the stamped parts (1, 18, 19) are arranged congruently with respect to one another (see the specification at lines 10-16 of page 6, lines 11-14 of page 8, and lines 16-19 of page 9; and Figures 1, 3, and 5). At least one of the middle stamped part's holes (4, 5) has a hole wall (8) which is provided with an elastomeric plastic cover (9) (see the specification from line 19 of page 6 to line 3 of page 7 and from line 20 of page 8 to line 3 of page 9; and Figs. 1, 3, and 5).

Independent claim 20 is directed to a gate plate for an automatic gear shift mechanism which has engagement holes (4, 5) for glidingly accommodating movable gear shift mechanism engagement elements (see the specification at page 1, lines 5-10; and Figures 1-5). The gate plate includes at least three stamped metal sheet parts (1, 18, 19) stacked together sandwiched (see the specification at lines 6-20 of page 8, and lines 16-19 of page 9; and Figs. 4 and 5). Each of the metal sheet parts (1, 18, 19) includes at least one engagement hole (4, 5) aligned with engagement holes (4, 5) in the other metal sheet parts (1, 18, 19) (see the specification at lines 10-16 of page 6, lines 11-14 of page 8, and lines 16-19 of page 9; and Figures 1, 3, and 5). An elastomeric plastic cover (9) is provided to surround at least a portion of the engagement hole (5) in the middle one (1) of the metal sheet parts (1, 18, 19) (see the specification from line 19 of page 6 to line 3 of page 7 and from line 20 of page 8 to line 3 of page 9; and Figs. 1, 3, and 5).

Grounds of Rejection to Be Reviewed on Appeal

Claims 1, 4, 8, 20, 24, and 25 have been rejected under 35 U.S.C. §102(e) as being anticipated by *Sander* (US 6,182,527).

Argument

Rejection under 35 u.s.c. §102(e) over *sander* (us 6,182,527)

The Examiner finally rejected Claims 1, 4, 8, 20, 24, and 25 under 35 U.S.C. §102(e) as being anticipated by *Sander* (US Patent 6,182,527). The final rejection is improper because Applicants' Declaration, submitted under 37 CFR 1.131 with the February 11, 2004 Amendment, establishes that the *Sander* patent is not prior art under 35 U.S.C. §102(e).

Claims 1, 4, and 8

When any claim of an application is rejected, a declaration may be submitted to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. 37 CFR §1.131(a) (2005). However, prior invention may not be established if the rejection is based upon a reference which claims the same patentable invention as defined in 37 CFR §41.203(a), in which case an applicant may suggest an interference. 37 CFR §1.131(a)(1) (2005).

37 CFR §41.203(a) states “[a]n interference exists if the subject matter of a claim of one party would , if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing part *and vice versa*.” (Emphasis added). Under this two-way test, invention “A” is the same patentable invention as an invention “B” only when invention “A” anticipates or makes obvious invention “B,” and invention “B” anticipates or makes obvious invention “A.” *Eli Lilly v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1268 (Fed. Cir. 2003). This two-way unpatentability test has always been used by the US PTO to determine whether claimed inventions interfere. 69 Fed. Reg. 49969 (August 12, 2004). The one-way unpatentability test has never been the standard for interfering subject matter and has been rejected by the US PTO as “unworkable.” 69 Fed. Reg. 49992.

Importantly, the fact that the patent may *disclose* subject matter claimed by an applicant is not a basis for interference if the patent does not *claim* that subject matter. *Manual of Patent Examining Procedure (MPEP)*, §2306 (8th ed. 2004).

Applicants submitted, together with the February 11, 2004 Amendment, a Declaration under 37 CFR 1.131 showing that the claimed invention was made prior to July 2, 1999, which was the filing date of the *Sander* patent.

The Declaration can be used under 37 CFR §1.131(a)(1) to establish prior invention over *Sander*, because under the two-way unpatentability test *Sander*’s

claimed invention is not the same as Applicants' claimed invention. For example, *Sander's* claimed invention does not anticipate or make obvious Applicants' claimed invention.

With respect to Applicants' independent Claim 1, *Sander's* claimed invention does not teach or suggest three stamped parts that lie flat *sandwiched* against one another. *Sander* claims a first flat latching part and additional flat latching parts, but does not claim that the latching parts are sandwiched against one another. Additionally, the three stamped parts of Applicants' Claim 1 each have at least two engagement holes. *Sander*, on the other hand, claims only "openings formed in the additional parts," but does not claim that the first flat latching part has any engagement holes. Furthermore, Applicants' Claim 1 recites that the engagement holes in the stamped parts are arranged *congruently* with respect to one another. *Sander* does not claim this limitation.

Consequently, Claim 1 is not the same as any of *Sander's* claims under the two-way unpatentability test. And each of the rejected claims depending from Claim 1 (i.e. each of Claims 4 and 8), therefore, is also not the same as any of *Sander's* claims.

The Examiner raised several arguments in the final Office Action dated November 3, 2004 (see paragraphs 1 and 3 on page 5). However, these arguments are insufficient to establish that *Sander's* claimed invention is the same as Applicants' claimed invention under the two-way unpatentability test.

First, the Examiner stated that "reasons are not required to reject the claims when the language of the claim have been anticipated by the reference and discussed in the rejections." (See paragraph 1 on page 5 of the Office Action dated November 3, 2004.) This statement was made in response to Applicants' argument that the Examiner had failed to provide reasons to support that *Sander's* claimed invention is the same as Applicants' invention. It is not clear to Applicants what the Examiner meant by this statement. And the Examiner

provided no legal authority to support this statement. Therefore, this statement does not establish that *Sander's* claimed invention is the same as Applicants' invention.

It should be noted again that under 37 CFR §1.131(a)(1) a declaration may not be used if the rejection is based upon a reference which *claims* the same invention. In such a case, interference should be declared. The MPEP also makes it clear that the fact that the patent may disclose an applicant's claim is not a basis for interference if the patent does not claim that subject matter. *MPEP* §2306. Therefore, *Sander's* disclosure, if not claimed, cannot be used in the two-way unpatentability test.

Second, the Examiner argued that for anticipation the reference must teach the claimed invention either explicitly or impliedly. He then proceeded to argue that it is implied that the sheet parts of *Sander* are sandwiched. (See paragraph 2 on page 5 of the Office Action dated November 3, 2004.) For the following reasons Applicants respectfully disagree.

The Examiner's arguments are wrong in law because he used the wrong legal standard, "impliedly," for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either *expressly or inherently* described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). To establish inherency, the missing limitation must be *necessarily* present in the reference, and it would be so recognized by persons of ordinary skill in the art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency may not be established by probabilities or possibilities. *Id.* Therefore, the "impliedly" standard is not part of the test for anticipation.

Even under the Examiner's own "impliedly" standard, his arguments are insufficient to establish anticipation, because he failed to provide any

explanation why it is implied that the sheet parts of *Sander* are sandwiched. The MPEP requires that the Examiner properly communicate the basis for a rejection so that an applicant can be given fair opportunity to reply. *MPEP*, §706.02(j). The MPEP further requires that where a claim is refused for any reason relating to the merits thereof the ground of rejection should be fully and clearly stated. *MPEP*, §707.07(d).

The Examiner's third argument is that the claims of *Sander* and Applicants' claims are "obvious variants." Again the Examiner failed to provide any explanation for his argument. As stated previously, such an argument does not provide fair opportunity for Applicants to reply, and is insufficient to support a rejection.

For the foregoing reasons, the rejection of Claims 1, 4, and 8 under 35 U.S.C. §102(e) as being anticipated by *Sander* is in error, and the Board is respectfully requested to reverse the rejection.

Claims 20, 24, and 25

Applicants' arguments against the rejection of Claims 1, 4, and 8 apply to the rejection of Claims 20, 24, and 25, except the argument that *Sander's* claimed invention is not the same as Claim 1 under the two-way unpatentability test. The reasons why *Sander's* claimed invention is not the same as Claim 20 under the two-way unpatentability test are separately provided below.

Sander's claimed invention does not anticipate or make obvious Applicants' Claim 20. For example, *Sander* does not claim "at least three stamped metal sheet parts stacked together *sandwiched*." *Sander* also does not claim "*each* of said metal sheet parts including at least one engagement hole." And *Sander* does not claim that the engagement holes are "*aligned*."

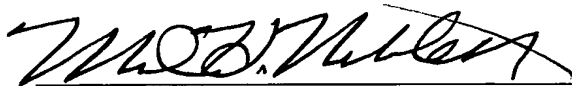
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Consequently, Claim 20 is not the same as any of *Sander's* claims under the two-way unpatentability test. And each of the rejected claims depending from Claim 20 (i.e. each of Claims 24 and 25), therefore, is also not the same as any of *Sander's* claims.

For the foregoing reasons, the rejection of Claims 20, 24, and 25 under 35 U.S.C. §102(e) as being anticipated by *Sander* is in error, and the Board is respectfully requested to reverse the rejection.

Respectfully submitted,

March 2, 2006

A handwritten signature in black ink, appearing to read "Gary R. Edwards", written over a horizontal line.

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Claims Appendix

The claims on appeal read as follows:

1. A functional component as a gate plate of an automatic gear shift mechanism with a locking gate, having engagement holes for engagement elements which kinetically interact with the functional component, wherein the functional component comprises at least three stamped parts, which lie flat sandwiched against one another, are unreleasably connected to one another and each have at least two engagement holes for engagement elements which kinetically interact with the functional component, the engagement holes in the stamped parts being arranged congruently with respect to one another, at least one of said holes, in a middle one of the stamped parts, having a hole wall which is provided with an elastomeric plastic cover.

4. Functional component according to Claim 1, wherein the plastic cover is formed by injection-moulding plastic around a hole edge.

8. Functional component according to Claim 4, wherein spacer lugs are formed from a material which is harder than the injection-moulded plastic on inner sides, of the outer stamped parts which face towards the middle stamped part.

20. A gate plate for an automatic gear shift mechanism which has engagement holes for glidingly accommodating movable gear shift mechanism engagement elements, comprising:

at least three stamped metal sheet parts stacked together sandwiched, each of said metal sheet parts including at least one engagement hole aligned with engagement holes in the other metal sheet parts,

and an elastomeric plastic cover provided to surround at least a portion of the engagement hole in a middle one of the metal sheet parts.

24. A gate plate according to Claim 20, wherein the elastomeric plastic cover is clicked into place on said metal part.

25. A gate plate according to Claim 20, wherein the elastomeric plastic cover is injection-moulded onto the middle part.